

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>007287.00020</b>													
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="padding: 5px;">Application Number <b>09/691792</b></td> <td colspan="2" style="padding: 5px;">Filed <b>October 18, 2000</b></td> </tr> <tr> <td colspan="4" style="padding: 5px;">First Named Inventor <b>Yakov Kamen</b></td> </tr> <tr> <td colspan="2" style="padding: 5px;">Art Unit <b>2421</b></td> <td colspan="2" style="padding: 5px;">Examiner <b>Dominic D. Saltarelli</b></td> </tr> </table>		Application Number <b>09/691792</b>		Filed <b>October 18, 2000</b>		First Named Inventor <b>Yakov Kamen</b>				Art Unit <b>2421</b>		Examiner <b>Dominic D. Saltarelli</b>	
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).            Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> applicant/inventor.   <input type="checkbox"/> assignee of record of the entire interest.            See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.            (Form PTO/SB/96)   <input checked="" type="checkbox"/> attorney or agent of record.            Registration number <u>62473</u>   <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34 _____         </td> <td style="width: 50%; vertical-align: top;"> <u>/Stephanie L. Knapp/</u>            _____            Signature   <u>Stephanie L. Knapp</u>            _____            Typed or printed name   <u>(202) 824-3000</u>            _____            Telephone number   <u>September 11, 2009</u>            _____            Date         </td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.            Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>62473</u>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/Stephanie L. Knapp/</u> _____ Signature  <u>Stephanie L. Knapp</u> _____ Typed or printed name  <u>(202) 824-3000</u> _____ Telephone number  <u>September 11, 2009</u> _____ Date										
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.															

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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The information provided by you in this form will be subject to the following routine uses:

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3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

**Yakov Kamen *et al.***

Serial No.: 09/691,792

Filed: October 18, 2000

For: METHOD AND SYSTEM FOR  
ADAPTIVE ELECTRONIC  
PROGRAMMING GUIDE

Atty. Docket No.: 007287.00020

Group Art Unit: 2421

Examiner: Dominic D. Saltarelli

Confirmation No.: 5769

**Pre-Appeal Brief Request For Review**

U.S. Patent and Trademark Office  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314  
Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

***Remarks***

Having received and reviewed the Final Office Action dated June 19, 2009 (hereinafter "Office Action", and the Advisory Action dated September 2, 2009 (hereinafter "Advisory Action", Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The Office made clear error in relying on the combination of U.S. Patent No. 5,798,785 to Hendricks (hereinafter "Hendricks") in view U.S. Patent No. 5,793,368

to Beer (hereinafter “Beer”) in its rejection of claims 10-22 as discussed in Applicants’ Response and Request for Reconsideration dated August 17, 2009, at pp. 5-6. Independent claim 10 recites, among other features,

receiving, at the broadcast receiving device, a user request to modify an electronic programming guide configured to display the electronic programming guide data;  
receiving, at the broadcast receiving device, one or more presentation criteria for making the user requested modification from the broadcast source; and  
determining, at the broadcast receiving device, at least one of the one or more presentation criteria corresponds to the user request.

- The Office Action alleges that the combination of Hendricks and Beer discloses all of the features of independent claim 10. Applicants respectfully disagree. The Office Action relies on Hendricks to show the claimed step of “receiving, at the broadcast receiving device, one or more presentation criteria for making the user requested modification from the broadcast source.” *See* Office Action, page 4. The Office Action concedes that “Hendricks fails to disclose receiving a user request to modify an electronic programming guide.” *Id.* Further, the Office Action alleges that Beer teaches the claimed steps of receiving, at the broadcast receiving device, a user request to modify an electronic programming guide and the “determining” step. *Id.* The Office Action relies on col. 3, lines 16-67 of Beer to show the claimed “determining” step. Specifically, the Office Action states that Beer describes “user requests for presentation criteria are a user request for a particular visual style or characteristic.” *Id.*
- The Advisory Action alleges that a determining step is one which interprets the user input in order to act upon it. *See* Advisory Action, page 3. The Advisory Action further alleges that “[s]ince the user input is selection criteria, a matching process is carried out which identifies which presentation criteria was selected, if any.” *Id.*
- Notably, claim 10 recites, “receiving, at the broadcast receiving device, *a user request to modify an electronic programming guide,*” and “receiving, at the broadcast receiving device, one or more presentation criteria for making the user

requested modification from the *broadcast source*.” Nowhere does claim 10 recite “user requests for presentation criteria,” as the Office Action suggests.

- Furthermore, even assuming, without conceding, that the processor in Beer corresponds to the claimed broadcast receiving device, at most, Beer discloses a user being able to select from a variety of different visual styles for a user interface on a processor or application on a processor, by adding, deleting, and changing attributes for widgets or objects associated with the user interface. *See*, Beer, col. 3, lines 16-17. Nowhere in Beer is there a teaching or suggestion that the processor determines at the broadcast receiving device, at least one or more presentation criteria corresponds to the user request, as recited in claim 10.
- Moreover, even assuming without conceding that Beer discloses a matching process, which is carried out when a user requests presentation criteria, as alleged in the Advisory Action, nowhere in Beer is there a teaching or a suggestion that the matching process occurs at the broadcast receiving device. Accordingly, Beer fails to teach or suggest the determining step as claimed.
- Hendricks fails to cure the deficiencies of Beer. The Action concedes that Hendricks fails to disclose receiving a user request to modify an electronic programming guide configured to display the electronic programming guide data. Accordingly, it then follows that, Hendricks can not *determine*, at the broadcast receiving device, at least one or more of the presentation criteria *corresponds to the user request*, as recited in claim 10. Therefore, claim 10 is patentably distinct over Hendricks in view of Beer.
- Claims 11-13 depend from independent claim 10 and are allowable for at least the same reasons as discussed above with respect to claim 10 and further in view of the additional novel and non-obvious features recited therein.
- Independent claims 14 and 18 recite language substantially similar to claim 10 and are thus allowable for substantially similar reasons as those discussed above with respect to claim 10. Claims 15-17 and 19-22 depend from claims 14 and 18, respectively, and are thus allowable for at least the same reasons as their respective

base claims, and further in view of the additional novel and non-obvious features recited therein.

While Applicants believe that the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. Applicants further reserve the right to address the rejections of any other claims not identified above on appeal should the appeal of this case proceed after the Office's consideration of this paper.

### ***Conclusion***

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3130.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: September 11, 2009

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